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1761  
JLW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Cheng

Serial No.: 10/043,814

Filed: 01/10/2002

For: Cookware with undulating cooking surface

Group Art Unit: 1761

Examiner: Alexander, Reginald

<b>Certificate of Mailing under 37 CFR 1.8</b> I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to: Mail Stop <u>Amendment</u> Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 on <u>9/10/2004</u> Date <u>[Signature]</u> Signature <u>[Signature]</u> Edward S. Sherman
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**Response under 37 CFR 1.133(b): Substance of Interview held on Sept. 2, 2004**

**In Response to Applicants Noting of a Deficiency in the Prior Office Action**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Honorable Sir:

I was contacted by Examiner Alexander on Sept. 2, 2004, by phone, in response to my earlier phone calls and facsimile of August 25, 2004, attached hereto, pointing out an apparent deficiency in the last Office Action. The examiner clarified that he did not intend to invoke legal authority when he cited as a reason for rejection that

*“since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimal or working ranges involves only routine skill in the art”.*

The examiner admitted that the proceeding remark was made gratuitously, and was not intended as a formal basis of rejection.

As to the request for additional time to respond, the Examiner noted that it must be made in a formal response to the action. The Examiner did not believe I would be entitled to such an extension of time, as he indicated does not intend to provide me with legal authority to support

the quoted contention. Accordingly, it was agreed that the examiner does not expect the future formal response to address the above contention.

However, the applicant wishes to take this opportunity to remind the examiner that if legal authority were provided to support the above contention, then as set forth in the earlier fax of Aug. 25, the applicant would be entitled to five additional days to respond and a refund of any extension fee. The applicants position is fully supported by the MPEP and Rule of Practice under 37 CFR, as the absence of a citation to legal authority constitutes a defect in the original office action, in that it is not complete as required under 37 CFR 1.104(b) and MPEP 707.06. In such circumstances **a new period for reply must be set as called for under MPEP 710.06.** Accordingly, the new period for reply should be reset for at least 5 days from the date at which legal authority is provided to the applicant, or otherwise the prior Office Action is otherwise amended in conformity with the formal withdrawal of the above contention.

It was agreed to hold a telephonic interview on matters of substance on Wednesday, Sept. 8, at 12:30 pm, PST.

Respectfully submitted:

By:  on 9/2/2004

Edward S. Sherman, Ph.D.,

Patent Attorney (Reg. No. 43,115)

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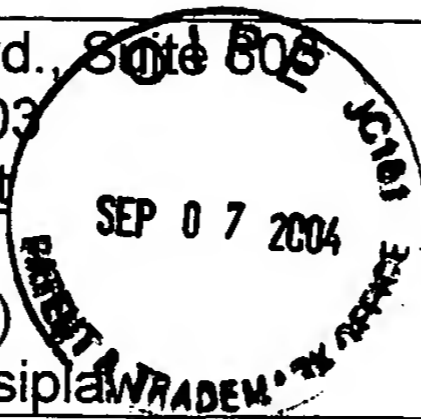
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Edward S. Sherman, Ph.D.  
Patent Attorney

**Fax**

**To:** Reginald L. Alexander, Primary Examiner **From:** Edward S. Sherman  
**Fax:** 703) 872-9306 ~~872-9306~~ **Pages:** 3  
**Phone:** 571-272-1395 **Date:** 8/25/2004  
**Re:** App. Serial No. 10/043,814 **Docket #:** 137.19

☐ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

Dear Sir,

Per my earlier phone message, please find attached an executed Power of Attorney and Statement under 37 CFR 3.73(b) admitting me in the captioned application. I am sending you these documents, as well as submitting to the PTO's central fax number, in the hope of arranging a telephone interview in the next several days, as I would like to file a response on behalf of my client before the expiration of the 3-month period on August 30, or as appropriately reset as requested below.

Further, I wish to point out that on page 3 of your office action of 4/30/2004 you assert the following without citation to legal authority:

*"since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimal or working ranges involves only routine skill in the art"*

Please provide the legal authority for this holding.

Further, as the absence of a citation to legal authority constitutes a defect in the original office action, in that it is not complete as required under 37 CFR 1.104(b) and MPEP 707.06. Therefore, **I respectfully request that a new period for reply be set as called for under MPEP 710.06.** Accordingly, the new period for reply should be reset for at least 5 days from the date at which you supply the above legal authority, or otherwise amend the office action.

I wish to apologize for this inconvenience on behalf of the earlier attorney of record in the case, who did not notice this deficiency in your action of 4/30/2004.

Sincerely,

Edward S. Sherman, Esq.

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